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REMARKS

The Examiner stated that claims 1-4, 9-11, 16-21 and 33 are directed to an invention that is independent or distinct from the invention originally claimed. The Examiner stated that original claims 5-8 were directed to an article including a color and protective layer and a layer on the color and protective layer, and pending claims 1-4, 9-11 and 16-21 are directed to an article including an uncoated color and protective layer. The Examiner also stated that original claim 4 was directed to an article including a layer between the color and protective layer and the polymer layer, and pending claims 21 and 33 are directed to an article having the color and protective layer directly on the polymer layer. The Examiner states that claims 1-4, 9-11, 16-21 and 33 are drawn to a non-elected invention. Applicant respectfully disagrees.

The Examiner cited section 821.03 of the MPEP. MPEP 821.03 states that if claims are added by amendment following an action by the Examiner to an invention other than previously claimed, the "Applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered."

Claims 1-4, 9-11, 16-21 and 33 are not drawn to an invention distinct from and independent of the invention previously claimed. Even though claims 1-4, 9-11 and 16-21 recite an uncoated color and protective layer and claims 21 and 33 recite an article having the color and protective layer directly on a polymer layer, original claim 1 was generic. Original claim 1 recited an article including a polymer layer and a color and protective layer comprised of a refractory metal compound or a refractory metal alloy compound. Therefore, claims 1-4, 9-11, 16-21 and 33 cannot be directed to an invention distinct from or independent of the invention previously claimed in original claim 1 because claim 1 is generic. The rejection is improper, and Applicant respectfully requests that the rejection be withdrawn.

Claims 5, 6, 12 and 13 are objected to under 37 CFE 1.75(c) as being of improper dependent form for failing to further limit the subject matter of the previous claim. Claims 5, 6, 12 and 13 have been cancelled.

Claims 5-6, 8, 12, 13, 22-24, 26-28, 30-32 and 34 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Welty (U.S. Patent No. 6,132,889) in view of Simmons, Jr (U.S. Patent No. 6,154,311). Claims 5, 6, 12 and 13 have been cancelled. Welty teaches a coated article including a nickel layer applied on a substrate 12. The Examiner admits that Welty does not disclose a polymer layer. The Examiner contends that Simmons teaches a hard polymer layer

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32 and it would be obvious to employ a polymer layer in Welty because of Simmons. Applicant respectfully disagrees.

First, Simmons is non-analogous art to Applicant's invention and to Welty. Next, there is no motivation or suggestion to modify Welty with Simmons. Each of these arguments will be discussed in greater detail below.

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). The Simmons reference is not analogous art to Welty or to Applicant's invention.

The Simmons reference is not in Welty or applicant's field and is not reasonably pertinent to the particular problem that the applicant has solved. Welty is directed to a coating that is declarative and provides abrasion protection, corrosion protection, and chemical resistance. Applicant's invention is directed toward a coated article having a decorative and protective coating. Simmons is directed to an ultraviolet reflective photocatalytic dielectric combiner that oxidizes bacteria and contaminants to make a surface self-cleaning, self-sanitizing, and self-deodorizing. Thus, Simmons's field is related to a self-cleaning surface, while Welty and Applicant's field concern decorative and protective coatings. These fields are very different from each other. Further, each of these fields has specific and unique design criteria and component characteristics, which are not compatible with each other.

Additionally, Simmons is not reasonably pertinent to applicant's particular problem. A reference is reasonably pertinent if, even though it may be in a different field of endeavor, it logically would have commended itself to an inventor's attention in considering his problem because of the matter with which it deals. In re Clay, 966 F. 2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992). As discussed above, Simmons is clearly not within the field of decorative and protective coatings, which is the subject to which applicant's invention is directed. Further, Simmons does not logically commend itself to the attention of an inventor seeking to solve problems present in decorating and protective coatings. This is because Simmons deals with the problems relating to self-cleaning and self-sanitizing a surface. This is far removed from applicant's problem of decorating and protecting a surface.

Moreover, even considering, arguendo, Simmons to be analogous art, the mere fact that the

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prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. There simply is no teaching, suggestion, or incentive in either of the applied references that would have led one of ordinary skill in the art to modify the Welty coating in the manner proposed by the examiner.

The examiner argues that it would have been obvious to one having ordinary skill in the art to provide the coating of Welty "with a polymer layer, as taught by Simmons Jr., because the polymer layer provides a viable alternative to electroplating in addition to providing corrosion resistance while leveling a substrate by forming a smooth hard surface." This is clearly a use of hindsight reconstruction. It is impermissible to engage in hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from the references to fill the gaps. The references themselves must provide some teaching whereby the applicant's combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18USPQ2d 1885, 1888 (Fed. Cir. 1991). There simply is no suggestion in the references, or in the prior art as a whole, that suggests the desirability of making the combination.

The examiner seeks to modify the coating of Welty to include the polymer layer of Simmons. First, assuming the examiner is arguing that the coating is modified to include a polymer layer, there would be no reason to modify Welty to include a polymer layer. Welty already has an electroplated nickel layer. The nickel layer provides a plating surface. To add a polymer layer would unnecessarily increase costs and make the coating more difficult to form.

If, on the other hand, the examiner is arguing that the coating of Welty is modified to replace the nickel layer with the polymer layer, there also is no suggestion to make this modification. It is impermissible to modify a base reference in a manner that defeats the benefits achieved by the teachings of the reference. Welty teaches that the nickel layer provides corrosion resistance and acts as a leveling layer to cover or fill imperfections in the substrate. To eliminate the nickel layer and replace the nickel layer with a polymer layer would defeat the benefits achieved by Welty. There is no support in Simmons that indicates the use of the polymer layer would satisfy all of the problems solved by using the nickel layer of Welty or that indicates the polymer layer performs in any way better than the structure already provided by Welty.

The examiner has pointed to no teaching in Simmons of any particular benefit to be derived from using the polymer layer instead of the nickel layer. Further, there is nothing in Welty that would have led one of ordinary skill in the art to believe that Welty's coating including a nickel

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layer was in any way deficient for Welty's purposes or was in need of modification. One of ordinary skill in the art would have found no reason, suggestion, or incentive for attempting to combine these references other than through the luxury of hindsight accorded one who first viewed applicant's disclosure. This is not a proper basis for a rejection under 35 U.S.C. 103.

The Examiner further objected to claim 25 under 35 U.S.C. §103(a) as being unpatentable over Welty in view of Simmons and Dewey (U.S. Patent No. 4,143,009). The Examiner asserts that Dewey teaches the use of an epoxy urethane, and claim 9 is obvious in view of the combination of Welty, Simmons and Dewey. Applicant respectfully disagrees.

Claim 25 is not obvious in view of the combination of Welty, Simmons and Dewey. The Dewey reference is not in Welty or applicant's field and is not reasonably pertinent to the particular problem that applicant has solved. Welty is directed to a coating for a faucet or a door knob that is declarative and provides abrasion protection, corrosion protection, and chemical resistance. Applicant's invention is directed toward a coated faucet or door knob having a decorative and protective coating. Dewey is directed to a coating for a golf club. Thus, Simmons's field is related to golf clubs, while Welty and Applicant's field concern faucets and door knobs. These fields are very different from each other. Further, each of these fields has specific and unique design criteria and component characteristics, which are not compatible with each other.

Additionally, Claim 25 depends on patentable independent claim 8 and is allowable for the reasons set forth above. Adding Dewey to the combination does not render claim 25 obvious. The combination of Welty, Simmons and Dewey does not disclose or suggest claim 25, and Applicant respectfully requests that the rejection be withdrawn.

The Examiner further objected to claims 28 and 29 under 35 U.S.C. §103(a) as being unpatentable over Welty in view of Simmons and Meckel (U.S. Patent No. 6,196,936). The Examiner asserts that Meckel teaches a silver or lustrous gray color, which the Examiner is interpreting as equivalent to nickel. The Examiner argues it would be obvious to use the refractory metal compounds or refractory metal alloy compounds of Meckel as the color and protective layer of Welty to provide a nickel color, and therefore Claim 28 and 29 are obvious. Applicant respectfully disagrees.

Claims 28 and 29 are not obvious in view of the combination of Welty, Simmons and Meckel. Claims 28 and 29 depend on patentable independent claim 8 and are allowable for the reasons set forth above. Adding Meckel to the combination does not render claims 28 and 29

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obvious. Claims 28 and 29 are not obvious, and Applicant requests that the rejection be withdrawn.

Thus, claims 1-4, 8-11 and 16-34 are in condition for allowance. No additional fees are seen to be required. If any additional fees are due, however, the Commissioner is authorized to charge Deposit Account No. 50-1482, in the name of Carlson, Gaskey & Olds, P.C., for any additional fees or credit the account for any overpayment. Therefore, favorable reconsideration and allowance of this application is respectfully requested.

Respectfully Submitted,

CARLSON, GASKEY & OLDS, P.C.




Karin H. Butchko Reg. No. 45,864
Attorneys for Applicant
400 West Maple Road, Suite 350
Birmingham, Michigan 48009
(248) 988-8360

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CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, 703-872-9306 on June 30, 2004.


Karin Butchko

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